

Remarks

Election of Claims

Applicant provisionally elects to prosecute Claims 1, 2, 4, 6, 7 and 9-13 of Group I with traverse. The non-elected claims of Group II are hereby withdrawn.

Background of the Law

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

The term “distinct” means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects. MPEP §802.01

Argument

I. Examiner has not demonstrated a Serious Burden

There is not a serious burden on the Examiner, because Group I and Group II are apart of the same classification 428. Even though the Examiner has cited to two different subclasses 76 and 166 for Group I and II respectively, both subclasses are equally applicable to Groups I and II.

Group I could also be classified under subclass 166. Subclass 166 is for Interlaminar Spaces and products wherein a nonplanar surface of a variable thickness layer comes into contact with an adjacent layer in such a manner as to define therebetween individual or interconnected

three-dimensional zones, either separate or interconnected. USPTO Subclass Definition for Subclass 166. Claim 1 from Group I includes interconnected three-dimensional zones, because of a “first heat insulative layer adjacent to said top outer layer, said first heat insulative layer having a plurality of first insulative elements disposed in spaced relation to each other on at least one surface of said first insulative layer”. More so, Claim 1 also includes a “second insulative layer positioned within the moisture-impervious chamber and comprising a plurality of insulative elements disposed in spaced relation to each other”. Therefore, Group I could also be sub-classified into Subclass 166 with first and second insulative layers

Group II could also be classified under subclass 76. Subclass 76 is for Complete Cover of Casing and is for products wherein all surfaces and edges of the sheet are enclosed. USPTO Subclass Definition for Subclass 76. Both Groups I and II have all surfaces and edges of sheet are enclosed, because both Groups contain the element that “top and bottom layers sealingly connected to each other at the boundaries of said outer layers to form a moisture-impervious chamber between said top and bottom outer layers”. Claim 1, Claim 7, Claim 14, & Claim 23. Therefore, Group II could also be sub-classified in subclass 76 for purposes of examination.

Moreover, the Examiner has distinguished Group I and Group II solely on the basis that the claims of Group II require that the moisture impervious layers be unslitted. It is noted, however, that each of the Group I claims also include the elements of moisture impervious layers, the only difference being that Claim II recites that the moisture impervious layers are unslitted. The state of being unslitted is a negative limitation which merely modifies the element of the moisture impervious layer. Applicants then envision no circumstance where a moisture impervious layer could be slitted without destroying the moisture impervious nature of the layer. Thus, the negative limitation of being unslitted in Group II is merely a further limitation which is within the logical scope of searching for impervious layers and, therefore, imposes no undue burden on the Examiner in searching such limitations together.

In conclusion, there is not a serious burden on the Examiner, as demonstrated by the same classification number 428, and that both Groups I and II can be sub-classified in subclasses 76 and 166. Patents are often classified under multiple subclasses. (*See e.g.* Patent No. 5,011,743)

II. The Examiner has not Properly Construed the Claims of Group I and Group II to Render Groups I and II Distinct

The Examiner has not properly read Claim 14's element that the "polymeric bottom outer layer being heat reflective". In passing upon questions of restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence. *See* MPEP §806.01. Claim 14 of Group II was specifically amended by applicant to include the element of a "polymeric bottom outer layer" where the "polymeric bottom outer layer *being heat reflective*". And Claims 1 and 7 of Group I include the element of the "outer layer comprising a polymer having *heat reflective elements* dispersed throughout said polymer". In comparison, both Claim 14 and Claims 1 and 7 necessarily have a bottom outer layer that is polymeric and *heat reflective*. Heat reflective elements are inherently present in polymeric heat reflective material in order to make it heat reflective. Therefore, Groups I and II have similar claimed subject matter to render them not distinct.

Also, the Examiner has not properly read Claim 14's element of a first and second plurality of "insulative elements disposed in spaced relation to each other". Claims 1 and 7 of Group I include the element of a plurality of "insulative elements disposed in spaced relation to each other. Therefore, in comparison, both Groups I and II contain the same subject matter as not render them distinct.

Finally, the Examiner has not properly construed Group II's bubble layers. Claim 14 of Group II indicates that a "first bubble-type heat *insulative layer* disposed in said chamber" and "a second bubble-type heat *insulative layer* disposed in said chamber". Claim 14 necessarily contains two insulative layers between the outer and inner layers, which are merely a bubbled-type. Claim 1 of Group I includes "a first heat insulative layer adjacent to said top outer layer" and "a second heat insulative layer positioned within the moisture-impervious chamber". So in comparison, both Claim 14 and Claim 1 include "heat insulative layers between the outer and inner layers"; however, Claim 14 merely defines a specific embodiment of the insulative layers, such as a different species of Claim 1.

Conclusion

In light of the preceding discussion, Applicant provisionally elects Group I with traverse. On this basis, Applicant submits that the claims have been improperly restricted.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Rosenbaum & Associates, P.C. deposit account No. 18-2000. Should the Examiner require any further information or wish to discuss an aspect of this Response, the Examiner is encouraged to telephone the undersigned at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Rosenbaum', with a long horizontal flourish extending to the right.

David G. Rosenbaum
Reg. No. 31,872

June 6, 2006

ROSENBAUM & ASSOCIATES, P.C.
650 Dundee Road
Suite 380
Northbrook, IL 60062
Direct Tel. 847-770-6010
Tel. 847-770-6000
Fax. 847-770-6006
E-mail: drosenbaum@biopatentlaw.com